

AUG 29 2006

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3626
PATENT
Application # 09/945,038
Attorney Docket # 1070-002

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the following remarks.

Claims 1 through 4 are now pending in this application. Claim 1 is in independent form.

I. The Obviousness Rejections

Each of claims 1 through 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,584,445 ("Papageorge") and U.S. Patent No. 5,724,379 ("Perkins"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered....'" MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is "reasonably pertinent to the particular problem with which the invention was involved." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530,

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1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441. F.3d 977 (Fed. Cir. 2006).

"References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art." *In re Kahn*, 441. F.3d 977 (Fed. Cir. 2006) ("[I]t is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor" (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Kahn*, 441. F.3d 977 (Fed. Cir. 2006) (citing *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *In re Kahn*, 441. F.3d 977 (Fed. Cir. 2006) (quoting *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

4. Motivation or Suggestion to Combine Prior Art References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." See, MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must clearly and objectively prove "the reasons one of ordinary skill in the art would have been motivated to select the references". *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

Further, "the examiner must show reasons that the skilled artisan, confronted with the

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same problems as the inventor and with no knowledge of the claimed invention, **would select the elements** from the cited prior art references for combination **in the manner claimed.**" (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

To show these reasons, "[p]articular findings must be made". *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by "concrete evidence in the record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be "clear and particular". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161 (Fed. Cir. 1999). That strong showing is needed because, "**obviousness requires proof** 'that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed'". *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Thus, the Office Action must clearly, particularly, and objectively prove some "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; and

"combine [those teachings] in the way that would produce the claimed" subject matter.

In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). *See also, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing "the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant") (emphasis added); and *Interconnect Planning Corp. v. Fell*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."). "The absence of . . . a suggestion to combine is dispositive in an obviousness determination." *Gambro Lundia AB v.*

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Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, these requirements apply regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

B. Analysis

1. Claim 1

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 1, from which each of claims 2-4 depend, states, *inter alia*, “**providing, to the particular healthcare consumer, information relating to said previously diagnosed condition**

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from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality".

The present Office Action applies col. 2, lines 5-15, col. 2, lines 30-36, and col. 2, line 66 – col. 3, line 27 of Perkins in support of the rejection. Yet one of the applied portions of Perkins recites, at col. 2, lines 5-15:

[s]eparately from the computer processing, we group the diseases experienced by the patients in the population into groups that differ from each other in the clinical complexity of treating the diseases, and we preferably rank these groups in orders of clinical complexity ranging from less clinically complex to more clinically complex. We then divide the patients of the population into the different groups of clinical complexity by assigning each patient to one of the groups based on clinical information or indicators available in the data bases for age, gender, diagnoses, and preferably comorbidity and utilization of selected procedures indicative of a patient's health status and disease history.

Another applied portion of Perkins states, at col. 2, lines 30-36:

[a]lso, by using the systematic relationships of the compared criteria to the clinical complexity groups, we can compare utilization of procedures, and indicia of quality of health care services rendered to different groups of patients by different providers, independently of the clinical complexity of treating the diseases of the provider's patients.

The remaining applied portion of Perkins states, at col. 2, line 66 – col. 3, line 27:

[o]ur invention involves comparing health care services independently of the clinical complexity of treating the diseases of the patients receiving the services so that provider comparisons made equivalent by our method can be used to improve the efficiency of the health care services. Making these comparisons involves computer processing of health care experience data to provide more useful information to group procurers of health care. The source of the data to be processed is generally claims records of health care experience covered by a health care insurance plan, an employee health plan, a health maintenance organization, or some other organization

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that pays for health care on a group basis. The data involved is generally in the form of claims information that have been entered into a computer, in the course of paying the claims; and the data represents the health care experience and related information on a population of patients. Although the available data has different structural and organizational forms, common inputs generally exist among the available data bases, because of the conventions normally used in the payment processing of health insurance claims. The common inputs include an identifier for the patient being treated, and an identifier for the provider of the health care service, the age and gender of the patient, a standardized code indicating each diagnosis, another standardized code indicating the procedure performed, the date and location of the service, and the procedures utilized. From this data, which is common to health care insurance records, we can derive considerable information having comparative value.

Applicant respectfully asks where any of these applied portions of Perkins teach:

- a. "providing" anything to "the particular healthcare consumer"?
- b. "providing" "the particular healthcare consumer" "information relating to said previously diagnosed condition from at least one database"?
- c. "providing" "the particular healthcare consumer" "information comprising" "a measure of the healthcare provider's charges"?
- d. "providing, to the particular healthcare consumer, information relating to said previously diagnosed condition from at least one database, said information comprising, with respect to treating the previously diagnosed condition in other healthcare consumers, for each of a plurality of healthcare providers, a measure of the healthcare provider's charges and a measure of the healthcare provider's quality"?

Applicant respectfully submits that the applied portion of Perkins fails to teach at least this claimed subject matter.

Claim 1, from which each of claims 2-4 depend, states, *inter alia*, "receiving, from the particular healthcare consumer, a plurality of criteria related to selecting a desired healthcare provider to treat the previously diagnosed condition".

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The present Office Action applies col. 2, lines 5-15 of Perkins in support of the rejection. This applied portion of Perkins is provided, *supra*. Applicant respectfully asks this applied portions of Perkins teaches:

- a. "receiving" anything from "the particular healthcare consumer"?
- b. "receiving, from the particular healthcare consumer, a plurality of criteria related to selecting a desired healthcare provider to treat the previously diagnosed condition"?

Applicant respectfully submits that the applied portion of Perkins fails to teach at least this claimed subject matter.

Claim 1, from which each of claims 2-4 depend, states, *inter alia*, "identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria".

The present Office Action applies col. 2, lines 5-15 and lines 30-36 of Perkins in support of the rejection. Both portions of Perkins applied in this portion of the rejection of claim 1 are provided, *supra*. Applicant respectfully asks either of these applied portions of Perkins teach:

- a. "identifying" anything to "the particular healthcare consumer"?
- b. "treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria"?
- c. "identifying" to "the particular healthcare consumer" "treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria"?
- d. "identifying, to the particular healthcare consumer, treatment options for said previously diagnosed condition, said identified treatment options comprising a listing of the plurality of healthcare providers ranked according to one or more of the prioritized criteria"?

Applicant respectfully submits that the applied portion of Perkins fails to teach at least this claimed subject matter.

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The applied portions of Papageorge fail to cure at least these deficiencies of the applied portions of Perkins.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified or combined, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of this rejection is respectfully requested.

c. Papageorge Teaches Away

Claim 1 recites "without involving a medical professional". Nothing in Papageorge would suggest to a person of ordinary skill in the art that a combination should be made with Perkins to arrive at this claimed subject matter. Indeed, Papageorge teaches away from any such modification to arrive at the claimed subject matter because Papageorge allegedly discloses a "computerized health evaluation system for **joint patient and physician decision making** concerning particular medical diseases and conditions" (emphasis added). *See* Abstract. Since Papageorge teaches away from the claimed subject matter, any combination with any other applied reference is impermissible. For at least this reason, Applicant respectfully requests a withdrawal of the rejection of claim 1.

2. Claim 2

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

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b. Missing Claim Limitations

Applicant respectfully incorporates by reference each argument presented regarding claim 1, since claim 2 depends from claim 1.

c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”, for the additional subject matter of claim 2:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**.” Thus, the Office Action fails to present the required **proof** of obviousness. For at least this reason, Applicant respectfully requests withdrawal of the obviousness rejection of claim 2.

3. Claim 3

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Applicant respectfully incorporates by reference each argument presented regarding claim 1, since claim 3 depends from claim 1.

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Moreover, claim 3 states, *inter alia*, “correlating the identified treatment options with the plurality of criteria, **the plurality of criteria selected and ranked by the particular healthcare consumer.**”

The present Office Action applies col. 6, line 66 – col. 7, line 7 of Papageorge in support of the rejection. Yet the applied portion of Papageorge recites, at col. 6, line 66 – col. 7, line 7:

[o]n electronic platforms, the patient will read screen text explaining the disease and all treatment options. After reading this overview, the patient then answers the questionnaire, using single keystrokes to select choices. This feature will maximize the number of patients who will use the system. The patient is asked about his/her functional status and how much it may be impaired; whether work, family, lifestyle, and/or future plans are affected; and treatment preferences, given the different probable risks associated with each one.

Applicant respectfully asks where any of these applied portions of Perkins teach:

- a. that any criteria are “ranked”?
- b. that “the plurality of criteria” are “ranked by the particular healthcare consumer”?
- c. “correlating the identified treatment options with the plurality of criteria, the plurality of criteria selected and ranked by the particular healthcare consumer”?

c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”, for the additional subject matter of claim 3:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination.**” Thus, the Office Action fails to present the required **proof** of obviousness. For

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at least this reason, Applicant respectfully requests withdrawal of the obviousness rejection of claim 3.

4. Claim 4

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Missing Claim Limitations

Applicant respectfully incorporates by reference each argument presented regarding claim 1, since claim 4 depends from claim 1.

c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”, for the additional subject matter of claim 4:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**.” Thus, the Office Action fails to present the required **proof** of obviousness. For at least this reason, Applicant respectfully requests withdrawal of the obviousness rejection of claim 4.

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II. The Finality of the Office Action is Improper, Premature, and should be Withdrawn

Applicant respectfully submits that no *prima facie* rejection of any claim has been established. For at least this reason, Applicant respectfully submits that the finality of the 31 May 2006 Office Action is premature. Thus, Applicant respectfully requests that the finality of the 31 May 2006 Office Action be withdrawn.

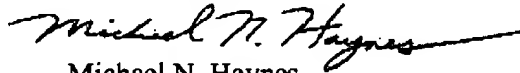
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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